

REMARKS/ARGUMENTS

Claims 1-38 have been resubmitted. Claims 1, 2, 8, 9, 13-22, 26, and 30-38 have been amended. Claims 5, 6, 23, and 25 have been canceled. No New Claims have been added.

The Examiner rejected Claims 1, 3, 9, 10, 22, 24, 26, and 27 under 35 U.S.C. § 102(b) as being anticipated by Kuhn. (U.S. Patent No. 5,482,593; "Kuhn"). Additionally, the Examiner rejected Claims 5, 7, 13-17 and 30-34 under 35 U.S.C. § 102(b) as being anticipated by Rossini (U.S. Patent No. 5,261,996; "Rossini").

The Examiner allowed Claims 11, 12, 28, and 29, for which the Applicant thanks the Examiner.

The Examiner objected to Claims 2, 4, 6, 8, 18-21, 23, 25 and 35-38 as containing allowable subject matter. No statute or regulation was cited for authority to object these claims. Applicant assumes that the Examiner meant that Claims 2, 4, 6, 8, 18-21, 23, 25 and 35-38 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has acted accordingly.

Kuhn

The Kuhn document appears to disclose an apparatus and a method for applying adhesive tape to a moving web. (Abstract, lines 1-2). A vacuum wheel 28, with a circumferential portion 28A, receives a strip of tape and supplies the tape to the moving web. (Abstract, lines 9-10; Figure 1).

Rossini

The Rossini document seems to disclose an applicator wheel and a guide system for aligning and positioning web material. (Abstract, lines 1-2).

35 U.S.C. § 102 Rejections

Claims 1, 3, 9, 10, 22, 24, 26, and 27:

The Examiner rejected Claims 1, 3, 9, 10, 22, 24, 26, and 27 under 35 U.S.C. § 102(b) as being anticipated by Kuhn.

Claim 1:

The Kuhn document does not appear to disclose or suggest an apparatus for applying a strip material to a web, "wherein the web comprises an organic photoconductor material" as claimed at line 6 of independent claim 1, as amended. In particular, the Kuhn document does not seem to disclose or suggest an organic photoconductor (OPC).

The insertion of the subject matter, of the web comprising an organic photoconductor material, is not new matter and this subject matter is supported in the original application at original Claim 2 ("2. The apparatus according to claim 1, in which the web contains an organic photoconductor material.") and original Claim 23 ("23. The apparatus according to claim 22, in which the web contains an organic photoconductor material.") and at the Abstract ("One purpose of the present invention is to provide a solution to the known problem of securing material to an organic photoconductor ("OPC") belt material in an automated manufacturing environment."). Thus, Applicant respectfully submits that independent claim 1, as amended, is patentable over the prior art of record, including the Kuhn document.

Claim 3:

The Examiner rejected Claim 3 under 35 U.S.C. § 102(b) as being anticipated by the Kuhn document, stating:

“With respect to claim 3, Kuhn teaches an applicator wheel that contains vacuum ports 28a along the circumference of the applicator wheel. See col. 5, lines 58-62.”

Applicant respectfully traverses this rejection. The Kuhn document does not appear to disclose the subject matter of Claim 3, in “which said applicator wheel contains vacuum ports along the circumference of said applicator wheel”. In fact, the Kuhn document does not appear to disclose any vacuum ports or any ports at all in any part of an applicator wheel. Instead, in the portion cited by the Examiner, item 28A is a “circumferential portion 28A” of the vacuum wheel 28. (Col. 5, lines 61-62).

The Kuhn document does not show the identical invention in as complete detail as is contained in Claim 3. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131. The Kuhn document does not anticipate Claim 3, as each and every element of the claimed invention does not seem to be disclosed in the Kuhn document. Furthermore, Applicant cannot find that the Kuhn document discloses the claimed invention as being arranged as in Claim 3. *Lindemann Maschinefabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

Applicant respectfully submits that Claim 3 is patentably distinguished over the Kuhn document for at least the foregoing reasons. Therefore, Applicants respectfully request removal of the rejection, and allowance of Claim 3.

EQ345495667US

Claims 9 and 10:

The Kuhn document does not appear to disclose or suggest a method for applying a strip material to a web, comprising the steps of, "aligning said strip material with the a bottom surface of an organic photoconductor web; and securing said strip material to said surface of said organic photoconductor web" as claimed at lines 6-9 of independent claim 9, as amended. In fact, the Kuhn document does not seem to disclose or suggest an organic photoconductor (OPC).

The insertion of the subject matter, of the aligning and securing strip material to the bottom surface of an organic photoconductor material, is not new matter and this subject matter is supported in the original application at lines 5-8 of Paragraph [0013] ("The code strip adheres to the belt material upon application of the pressure between the nip roll and the applicator wheel. After the code strip is secured to the web bottom surface, the strip and web move together away from the nip location.") and at lines 4-7 of Paragraph [0026] ("The code strip 51 adheres to the belt material 34 upon application of the pressure between the nip roll 45 and the applicator wheel 30. After the code strip 51 is secured to the web bottom surface, the strip 51 and web 34 move together away from the nip location.").

Thus, Applicant respectfully submits that independent Claim 9, as amended, is patentable over the prior art of record, including the Kuhn document. Applicant further respectfully submits that dependent Claim 10 (dependent upon Claim 9) is now also patentable over the Kuhn document, for at least the reasons stated above. Furthermore, as explained above regarding Claim 3, Kuhn does not seem to disclose vacuum ports. Thus, Applicant

requests that the Examiner remove the rejection to Claims 9 and 10 and thereafter allow Claims 9 and 10.

Claims 22 and 24:

Claim 22 was amended at line 6, by inserting "wherein the web comprises an organic photoconductor material," similar to the amendment described above regarding Claim 1. For at least the same reasons stated regarding Claim 1 above, Applicant respectfully submits that independent Claim 22 is patentable over the prior art of record, including the Kuhn document.

Applicant further respectfully submits that dependent Claim 24 (dependent upon Claim 22) is now also patentable over the Kuhn document, for at least the reasons stated above. Furthermore, as explained above regarding Claims 3 and 10, Kuhn does not seem to disclose vacuum ports. Therefore, Applicant respectfully requests entrance of this amendment, removal of the rejection, and allowance of amended independent Claim 22 and dependent Claim 24.

Claims 26 and 27:

Claim 26 was amended by inserting "aligning said strip material with ~~the~~ a bottom surface of an organic photoconductor web; and securing said strip material to said surface of said organic photoconductor web" at lines 6-9, similar to the amendment discussed above regarding Claim 9.

For at least the same reasons stated regarding Claim 9 above, Applicant respectfully submits that independent Claim 26 is patentable over the prior art of record, including the Kuhn document. Applicant further respectfully submits that

dependent Claim 27 (dependent upon Claim 26) is now also patentable over the Kuhn document, for at least the reasons stated above. Furthermore, as explained above regarding Claims 3, 10, and 24, Kuhn does not seem to disclose vacuum ports. Therefore, Applicant respectfully requests entrance of this amendment, removal of the rejection, and allowance of amended independent Claim 26 and dependent Claim 27.

Claims 5, 7, 13-17 and 30-38:

The Examiner rejected Claims 5, 7, 13-17 and 30-34 under 35 U.S.C. § 102(b) as being anticipated by Rossini.

Claim 5:

Claim 5 was cancelled. Thus Applicant respectfully submits that the rejection of Claim 5 is no longer pertinent.

Claim 7:

Claim 7 is dependent upon dependent Claim 3, which in turn is dependent upon independent Claim 1, as amended. For at least the reasons stated above regarding the patentability of independent Claim 1, as amended, and dependent Claim 3, Applicant respectfully submit that dependent Claim 7 is now patentable over the prior art of record, including the Rossini document. Therefore, Applicant respectfully requests removal of the rejection, and allowance of dependent Claim 7.

Claim 13-17:

Independent Claim 13 was amended similarly to the amendments discussed above regarding Claims 9 and 26. For at least the same reasons stated regarding Claims 9 and 26 above, Applicant respectfully submits that

EQ345495667US

independent Claim 13 is patentable over the prior art of record, including the Rossini document.

Applicant further respectfully submits that dependent Claims 14-17 (dependent upon Claim 13) are now also patentable over the Rossini document, for at least the reasons stated above. Therefore, Applicant respectfully requests entrance of this amendment, removal of the rejection, and allowance of amended independent Claim 13 and dependent Claims 14-17.

Claims 30-38:

Independent Claim 30 was amended similarly to the amendments discussed above regarding Claims 9, 13, and 26. For at least the same reasons stated regarding Claims 9, 13, and 26 above, Applicant respectfully submits that independent Claim 30 is patentable over the prior art of record, including the Rossini document.

Applicant further respectfully submits that dependent Claims 31-38 (dependent, directly or indirectly, upon Claim 30) are now also patentable over the Rossini document, for at least the reasons stated above. Therefore, Applicant respectfully requests entrance of this amendment, removal of the rejection, and allowance of amended independent Claim 30 and dependent Claims 31-38.

Claim 8, 14, and 15:

Claims 8, 14, and 15 have been amended to further describe the code strip. Claims 8 and 15 have been amended by inserting "XY patterns are located on said code strip." Claim 14 has been amended by inserting "said strip material comprises a code strip made of polymer material with fiduciary markings formed photographically."

Claims 8 and 15:

Neither the Kuhn document nor the Rossini document appear to disclose or suggest a method or an apparatus for applying a strip material to a web, "XY patterns are located on said code strip" as claimed at line 2 of Claim 8 and Claim 15, as amended. In particular, prior art of record does not seem to disclose or suggest an XY patterns or any other type of patterns on a code strip.

The insertion of the subject matter, of XY patterns located on the code strip, is not new matter and this subject matter is supported in the original application at Paragraph [0015] ("In addition, the joint could be detected by utilizing the XY patterns located on the code strip itself. Since there is a defined number of XY pattern stripes (see FIG. 3) within the code strip (e.g., n stripes per inch of code strip), the central processing unit can determine the position of the slice as a certain distance away from the XY pattern stripe (e.g., stripe #238 of 4,000 total stripes within the code strip) that has just been detected by the sensing means."); at Paragraph [0028] ("Also, the splice could be detected by utilizing the XY patterns located on the code strip itself. Since there is a defined number of XY pattern stripes (see FIG. 3) within the code strip (e.g., n stripes per inch of code strip), the central processing unit can determine the position of the slice as a certain distance away from the XY pattern stripe (e.g., stripe #238 of 4,000 total stripes within the code strip) that has just been detected by the sensing means."); and Figure 3.

Thus, Applicant respectfully submits that Claims 8 and 15, as amended, are patentable over the prior art of record, including the Kuhn document and the Rossini document. Applicant respectfully requests that this amendment be entered and that Claims 8 and 15 be allowed.

Claim 14:

Neither the Kuhn document nor the Rossini document appear to disclose or suggest a method for applying a strip material to a web, wherein “said strip material comprises a code strip made of polymer material with fiduciary markings formed photographically.” as claimed at lines 2-3 of Claim 14, as amended. In particular, prior art of record does not seem to disclose or suggest a code strip of any particular composition or comprising any particular features.

The insertion of the subject matter, of a code strip made of polymer material with fiduciary markings formed photographically, is not new matter and this subject matter is supported in the original application at Paragraph [0008] (“A code strip is a graduated strip, generally disposed across an area where the medium is held, and having gradations that can be automatically sensed. Historically code strips have been made of polymer material with fiduciary markings formed photographically. For optimum performance, the code strip's fiduciary markings should be very close to both a light source and a detector used as parts of a sensing system for reading the fiduciary markings.”).

Thus, Applicant respectfully submits that Claim 14, as amended, is patentable over the prior art of record, including the Kuhn document and the Rossini document. Applicant respectfully requests that this amendment be entered and that Claim 14 be allowed.

Claims 16 and 33 regarding inherent anticipation:

Claims 16 and 33 refer to a method wherein “a guide sensor detects the position of said code strip material.” Regarding Claim 16, the Examiner remarked: “With respect to claim 16, Rossini teaches this limitation which is

EQ345495667US

inherent by design and function of the applicator 10.” Regarding Claim 33, the Examiner remarked: “With respect to claim 33, Rossini teaches this limitation which is inherent by design and function of the applicator 10.”

The Rossini document does not show the identical invention in as complete detail as is contained in Claims 16 or 33. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131. The Rossini document does not anticipate Claims 16 or 33, as each and every element of the claimed invention does not seem to be disclosed in the Rossini document. Furthermore, Applicant cannot find that the Rossini document discloses the claimed invention as being arranged as in Claims 16 or 33. *Lindemann Maschinefabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

Inherent anticipation, relied on by the Examiner, requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-1951 (Fed. Cir. 1999). See *Trintec Industries v. Top-U.S.A. Corp.*, 295 F.3d 1292, U.S.P.Q.2d (BNA) 1597 (Fed. Cir. 2002). Consequently, Applicants respectfully submit that detecting position of a code strip is not inherent to “applicator machines.” Indeed, if Kuhn is (like Rossini) also considered to be an “applicator machine, then detecting position of a code strip would be inherent to the Kuhn device. However, Kuhn does not appear to disclose a code strip. Thus, detecting a code strip cannot be inherent to “applicator machines.”

Applicants respectfully request that the Examiner provide the basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the Foote document. *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. &

Inter. 1990) (emphasis in original); M.P.E.P. § 2112. Nevertheless, the amendments discussed above regarding the independent Claims 13 and 30 (for dependent Claims 16 and 33, respectively) should now permit finding Claims 16 and 33 patentable over the prior art of record.

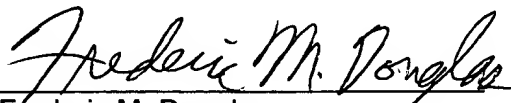
Applicant respectfully submits that Claims 16 and 33 are patentably distinguished over the Rossini document for at least the foregoing reasons. Therefore, Applicants respectfully request entrance of this amendment, removal of the rejection, and allowance of Claims 16 and 33.

CONCLUSION

Entry of the amendments to the claims is respectfully requested. Reconsideration and withdrawal of the Office Action with respect to Claims 1-38 is respectfully requested. Applicant respectfully requests the prompt issuance of a notice of allowance of all claims. In the event the examiner wishes to discuss any aspect of this response, please contact the attorney at the telephone number identified below.

Respectfully submitted,

By:

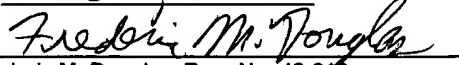

Frederic M. Douglas
Attorney Registration No. 48, 813

Frederic M. Douglas.
15333 Culver Drive
Suite 340 PMB 114
Irvine, CA 92604-3051
(949) 293-0442

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail # EQ 345495667 US (Post Office to Addressee) in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on Dec 13 2005


Frederic M. Douglas, Reg. No. 48,813

EQ345495667US